

Application No. 10/576,969
Amendment dated November 17, 2008
Reply to Office Action of August 15, 2008

REMARKS/ARGUMENTS

This amendment is submitted under 37 C.F.R. § 1.111 in response to the Office Action of August 15, 2008. Reconsideration of this application is respectfully requested.

Claims 13-28 are pending in the application with claims 16, 18, and 20 having been amended, new claims 21-28 having been added, and claims 1-12 having been canceled.

1. Rejection under 35 U.S.C. § 112, First Paragraph

Claims 11-20 have been rejected under 35 U.S.C. 112, first paragraph, because, according to the Examiner:

[T]he specification, while being enabling for an invention comprising compound Ia, i.e., 2,6-dichloro-N-{[3-chloro-(trifluoromethyl)-2-pyrindyl]methyl}benzamide plus tolylfluanid in a ratio range of 1:5 to 1:10, does not reasonably provide enablement for the invention comprising compound Ia, i.e., 2,6-dichloro-N-{[3-chloro-(trifluoromethyl)-2-pyrindyl]methyl}benzamide plus tolylfluanid in the broad ratio range of 0.01 to 10. The specification is not enabling for an invention comprising N-{[3-chloro-5-(trifluoromethyl)-2-pyrindyl]methyl}-2-fluoro-6-nitrobenzamide (compound Ib) or N-{[3-chloro-5-(trifluoromethyl)-2-pyrindyl]methyl}-2-fluoro-6-nitrobenzamide (compound Ic) plus tolylfluanid.

Compounds Ib and Ic differ in chemical functionality from compound Ia.

Therefore, the activity of compound Ia would not render the activity of compound Ib and Ic obvious. Small changes in chemical functionality on a chemical

Application No. 10/576,969
Amendment dated November 17, 2008
Reply to Office Action of August 15, 2008

structure core may affect the activity of a compound. The specification is also not enabling for an invention comprising preventing or curing fungi growth. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Claims 11 and 12 have been canceled.

Claims 13-20 have been amended to read on an (A)/(B) weight ratio of from 0.1 to 0.2.

Claims 13-20 are directed to a composition wherein (A) is selected from the group consisting of 2,6-dichloro-N-{{3-chloro-5-(trifluoromethyl)-2-pyridinyl]methyl}-benzamide; N-{{3-chloro-5-(trifluoromethyl)-2-pyridinyl]methyl }-2-fluoro-6-nitrobenzamide; and N-{{3-chloro-5-(trifluoromethyl)-2-pyridinyl]methyl}-2-methyl-6-nitrobenzamide. The Examiner has acknowledged on page 4 of the current Office Action that these three compounds are known fungicides and that WO 03/034824 teaches that they are used to control fungi growth. Thus, these three fungicides are known to those skilled in the art as recognized equivalents. It is therefore submitted that it is entirely proper for the claims of the present application to be directed to all three of these equivalents, rather than only one.

Claims 13-20 have also been amended to be directed to a method for *controlling* phytopathogenic fungi of crops. That is to say, the phrase “preventively or curatively” has been deleted.

Application No. 10/576,969
Amendment dated November 17, 2008
Reply to Office Action of August 15, 2008

Accordingly, it is requested that the rejection of claims 11-20 under 35 U.S.C. 112, first paragraph, be withdrawn.

2. Rejection under 35 U.S.C. § 103(a)

Claims 11-20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Mercer et al. (WO 03/034824; 5/1/03) and THE AGROCHEMICALS HANDBOOK, 3rd edition, A0400, August 1991.

The Examiner has acknowledged that “[t]he specification provides unexpected (synergistic) results for the composition / method comprising a compound of formula Ia . . . and tolylfluanid in a ratio range from 1:5 to 1:10. All of the claims currently pending in the application are directed to compositions present in a ratio range from 1:5 to 1:10.” As pointed out above, claims 13-20 are more broadly written to be directed to a composition wherein (A) is selected from the group consisting of

2,6-dichloro-N-{[3-chloro-5-(trifluoromethyl)-2-pyridinyl]methyl}-benzamide; N-{[3-chloro-5-(trifluoromethyl)-2-pyridinyl]methyl }-2-fluoro-6-nitrobenzamide; and N-{[3-chloro-5-(trifluoromethyl)-2-pyridinyl]methyl}-2-methyl-6-nitrobenzamide. As stated above, these three fungicides are known to those skilled in the art as recognized equivalents and should therefore should all be permitted to be within the scope of the claims. Limiting the Applicants to only one of three art recognized equivalents would be clearly unfair in view of the teaching of the present specification.

Application No. 10/576,969
Amendment dated November 17, 2008
Reply to Office Action of August 15, 2008

Accordingly it is requested that the rejection of claims 11-20 under 35 U.S.C. § 103(a) as being unpatentable over Mercer et al. and THE AGROCHEMICALS HANDBOOK, 3rd edition, A0400, August 1991, be withdrawn.

3. Obviousness-Type Double Patenting

Claims 11-20 have been provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-18 of co-pending Application No. 11/884,154.

As pointed out in the Office Action, a timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.

The present application and U.S. Patent Application No. 11/884,154 are commonly owned by BAYER CROPSCIENCE S.A., 16, Rue Jean-Marie LeClair, F-69009 Lyon, France.

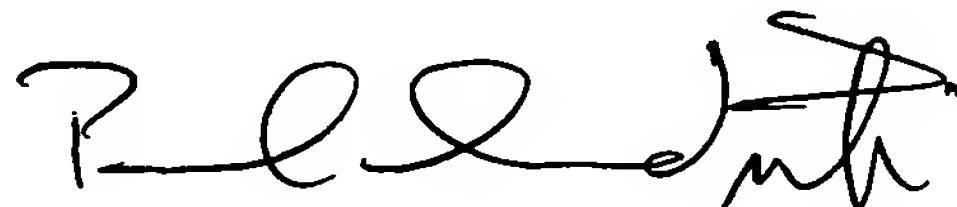
A Terminal Disclaimer under 37 C.F.R. 1.321(b) and (c) disclaiming, with the customary exceptions, the terminal part of the statutory term of any patent granted on the instant application that would extend beyond the expiration date(s) of the full statutory term(s) of any patent(s) issued on U.S. Patent Application No. 11/884,154 is filed herewith.

Accordingly, it is requested that the provisional rejection of claims 11-20 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-18 of co-pending Application No. 11/884,154 be withdrawn.

Application No. 10/576,969
Amendment dated November 17, 2008
Reply to Office Action of August 15, 2008

In view of the foregoing, it is submitted that this application is now in condition for allowance, and an early Office Action to that end is earnestly solicited.

Respectfully submitted,



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